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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,385	02/23/2005	Akihisa Takaichi	Q86331	4927
23373 7590 06/23/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
GWARTNEY, ELIZABETH A				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,385

Applicant(s)

TAKAICHI ET AL.

Examiner

Elizabeth Gwartney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/23/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuchs et al. (WO 01/01789) in view of Emoto (US 6,458,395).

Regarding claim 1, Fuchs et al. disclose a gel composition comprising the following components and having a pH in the range of 3.5 to 4.1 (Abstract, P6/L1-2):

- Protein or its hydrolysate	2-4.5 wt% (P8/Table)
-Calcium	0.02-0.270 wt% (P5/Table)
-Acidulant	(P6/L2-5)
-Carbohydrate	11-20 wt% (P8/Table)
-Fat	(P4/L22-23 – lipid source optional)
-Water	~ 72-80 wt% (P6 – based on a solids content of 20-28% by weight)

Fuchs et al. does not explicitly disclose that the protein does not coagulate at pH 3 to pH 4 or a gel composition comprising agar.

Regarding coagulation, since the protein, whey protein isolate, disclosed by Fuchs is identical to that presently claimed, it is clear that it would intrinsically display the coagulation properties recited in the present claim.

Regarding agar, Emoto teaches a nutritionally balanced gelatinous food product which is a composite gel formed with a protein and a gelling agent such as agar (Abstract, C5/L24-25). Emoto teaches that agar has gelling and gel-stabilizing ability (5/L26-28).

Fuchs et al. and Emoto are combinable because they are concerned with the same field of endeavor, namely, nutritionally supplemented protein gels. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added agar, as taught by Emoto, to the gel composition of Fuchs et al. to provide gel strength and stability to the gelatinous food product.

Regarding claims 2-3, Fuchs et al. disclose all of the claim limitations as set forth above. Further, Fuchs et al. disclose a gel composition further comprising of 5-50 wt% fruit juice (P8/Table) and vitamin D in an amount of 0.25×10^{-6} to 0.625×10^{-6} wt% (P5/Table – where 1 IU of vitamin D = 0.025 µg).

Regarding claim 4, Fuchs et al. disclose all of the claim limitations as set forth above and that the protein is whey protein isolate (P3/L18-25, P8/Table). Since the protein disclosed by Fuchs is identical to that presently claimed, it is clear that it would intrinsically display the coagulation properties recited in the present claim.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 of copending Application No. 10/521,170. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Although the copending claims are drawn to a gel beverage composition while the present claims are drawn to a gel composition for protein and calcium supplementation, there is clear overlap between the present claims and the copending claims. Specifically, US appl. '170 claims a gel beverage composition having a pH of 3-4 and comprising protein which does not coagulate at pH 3-4, agar, water, acidulant, fat, and saccharide. Further, US appl. '170 claims a protein material which does not coagulate at pH 3-4 selected from the group consisting of protein hydrolysate having a number average molecular weight of 500-10000, whey protein concentrate, whey protein isolate and desalted whey. US appl. '170 also claims a gel composition containing a gelling agent selected from the group consisting of gellan gum, carrageenan, pectin and gelatin.

US appl. '170 does not teach a gel composition comprising 0.1-0.5 wt% calcium, 0.1 X 10^{-6} to 10 X 10^{-6} wt % vitamin D, or 0.1 to 20 wt% masking agent Fuchs et al. (WO 01/01789) teach a gel composition comprising 0.02 – 0.270 wt% calcium (P5/Table), 0.25 X 10^{-6} to 0.625 X 10^{-6} wt% vitamin D (P5/Table – where 1 IU of vitamin D = 0.025 µg) and 5-50 wt% fruit juice. Fuchs et al. teach that calcium and vitamin D are added to supplement the nutritional profile of the gel composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added calcium, vitamin D and fruit juice, as taught by Fuchs et al., to the gel composition of US appl. '170 for the purpose of improving the nutritional and flavor quality of the gel composition.

Claims 1-4 directed to an invention not patentably distinct from claims 1-7 of commonly assigned US appl. '170. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US Application 10/521,170, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(c), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

6. Claims 1-4 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/521,170 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(c) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. For an explanation of the rejection, please see above.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date

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of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached Monday - Thursday; 7:30AM - 5:00PM EST, working alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794